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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,608	12/02/2003	Hiroyuki Kometani	380-45	3708
23117	7590	08/26/2004	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			SERGEANT, RABON A	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/724,608	Applicant(s) KOMETANI ET AL.	
	Examiner Rabon Sergeant	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/973,747.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 13-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 284015 in view of Nakamura et al. ('034).

EP 284015 discloses a two component polyurethane sealant comprising blocked 1,8-diaza-bicyclo(5,4,0)undecene-7 as catalyst. The reference further discloses that the blocking agent for the catalyst may be a carboxylic acid having from 2 to 18 carbon atoms. See abstract and page 4, lines 22-57.

3. Though the primary reference discloses the blocking of the catalyst with a carboxylic acid, the reference fails to specifically disclose the use of an unsaturated carboxylic acid corresponding to those of applicants. However, the use of 1,8-diaza-bicyclo(5,4,0)undecene-7 blocked with an unsaturated carboxylic acid, such as crotonic acid, as a catalyst for polyurethanes was known at the time of invention. This position is

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supported by Nakamura et al. at column 5, lines 1-40. Furthermore, since the blocked catalyst forms in a one to one ratio, applicants' claimed ratio limitations are considered to be met.

4. Therefore, since 1,8-diaza-bicyclo(5,4,0)undecene-7 blocked with an unsaturated carboxylic acid was a known catalyst for polyurethanes, the position is taken that it would have been obvious to utilize the catalyst of the secondary reference as the blocked catalyst within the two component polyurethane sealant of the primary reference. It has been held that it is prima facie obvious to utilize a known component for its known function. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

5. The examiner has considered applicants' response of June 8, 2004; however, applicants' arguments are deficient for the following reasons. Firstly, applicants' argument that the instant invention does not require an amine curing agent is irrelevant, because applicants' claims are open to the inclusion of any additional component, including the argued curing agent. Secondly, applicants' argument that Nakamura et al. is irrelevant to the production of a two component polyurethane sealant is not agreed with because one of ordinary skill would have expected that the catalysts of the respective references would have had the same catalytic effect in the reaction of isocyanate groups, regardless of whether a foam or sealant is produced. Furthermore, a foam and sealant are not mutually exclusive, since the foam may have sealing properties and foaming sealants were known. Thirdly, the argued passage at page 4, lines 44-45 of EP 284015 does not negate the references' aforementioned teachings regarding the reaction of carboxylic acids with the bicyclo amidine. Lastly, applicants' argument concerning the presence of

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the carbodiimidation catalyst within Nakamura et al. is irrelevant, because applicants' claims are open to the inclusion of the argued catalyst.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent  
August 22, 2004

  
RABON SERGENT  
PRIMARY EXAMINER